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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208873
Party	Defendant Sunflower Meadows Herb Farm LLC
Correspondence Address	ANTHONY J PALUMBO DRINKER BIDDLE & REATH 1500 K ST NW, SUITE 1100 WASHINGTON, DC 20005-1209 UNITED STATES dctrademarks@dbi.com, anthony.palumbo@dbi.com
Submission	Reply in Support of Motion
Filer's Name	Anthony J. Palumbo
Filer's e-mail	dctrademarks@dbi.com, anthony.palumbo@dbi.com
Signature	/anthony j. palumbo/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Serial No. 85/447,463
Filed: October 14, 2011
Published: September 18, 2012

<u>HERB PHARM, LLC.,</u>	:	
Opposer,	:	
v.	:	Opposition No. 91/208,873
SUNFLOWER MEADOWS	:	
HERB FARM LLC.,	:	
<u>Applicant.</u>	:	

APPLICANT’S REPLY IN SUPPORT OF ITS MOTION TO DISMISS

In its opposition (“Opp.”) to the motion to dismiss filed by Applicant Sunflower Meadows Herb Farm LLC (“Applicant”), Opposer Herb Pharm, LLC. (“Opposer”) devotes the bulk of its brief to arguing points not at issue. At the same time, Opposer concedes (or does not dispute) the points that form the essential basis of Applicant’s motion to dismiss – namely, that (a) the disclaimed words “herb farm” convey a merely descriptive meaning, which if true forecloses an opposition hinging only on those words, and (b) the only component of Applicant’s application that Opposer contends forms the basis of its Opposition is the disclaimed words “herb farm.”

These concessions reinforce the conclusion that Applicant’s request for a dismissal of this proceeding should be granted because, as a matter of law, there can exist no likelihood of confusion caused by Applicant’s use of the merely descriptive phrase “herb farm”.

ARGUMENT

A. Opposer's Argument Reinforces the Lack of an Actionable Claim

Opposer acknowledges that “[m]any companies use the words ‘herb farm’ in their names and trademarks,” Opp. at 9, effectively recognizing that third parties commonly use the merely descriptive phrase “herb farm” to either describe themselves or their products. Opposer further admits that the phrase “herb farm” is descriptive in nature because it is used by others to identify and describe goods and farms. Opp. at 8. This is precisely why Opposer may not premise its opposition solely on the disclaimed words “herb farm” which are admitted to be merely descriptive – and which would limit the scope of Applicant’s rights should its application proceed to registration.

As such, Opposer cannot be harmed by registration of Applicant’s Sunflower Mark¹ for herbal supplements and medicinal herbal preparations, herbal tea and herbal food beverages, and herbal juices. Yet, the Opposer is seeking to prevent Applicant from identifying and describing its products through incorporation of the phrase “herb farm.” The Opposer’s argument is made in direct contravention of the Supreme Court’s decision in *KP Permanent Make-Up Inc. v. Lasting Impression I Inc.*, 543 U.S. 111, 121-22 (2004); see also *Jean Patou, Inc. v. Jacqueline Cochran, Inc.*, 133 USPQ 242, 246 (S.D.N.Y. 1962) (“While it is desirable to protect a person



who has built up a public association with certain products under his trademark from having his business taken by somebody else, it is also undesirable to block the channels of expression by giving protection to everyone who may go out and appropriate an ordinary descriptive word for his own business use.”); *Surgicenters of America, Inc. v. Medical Dental Surgeries, Co.*, 202 USPQ 401, 406 (9th Cir. 1979) (“To allow trademark protection for generic terms, . . . even when [they] have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.”).

Opposer’s misunderstanding of the relevant issue in Applicant’s motion is reflected in its rote recitation of the *DuPont* factors in a likelihood of confusion analysis and its citation to inapplicable case law. However, what is telling about this analysis is that all arguments raised by Opposer are tethered solely to the alleged similarity of the disclaimed words “herb farm.” Not one aspect of Opposer’s argument is associated with any component of Applicant’s Sunflower Mark other than the merely descriptive words “herb farm”. Despite the irrelevance of Opposer’s argument, it is telling as it establishes that the entirety of Opposer’s claim of confusing similarity is based on Applicant’s use of the descriptive “herb farm” wording as a component of the Sunflower Mark.

The cases cited by Opposer in Section 1.a. of its opposition brief (Opp. at 4-5 – “Disclaimed portions of trademarks must be considered in the likelihood of confusion analysis”) are inappropriate to this motion and proceeding because the cited opinions do not address marks

that were contested solely based on disclaimed wording. This is a significant distinction that the Opposer fails to appreciate.

First, in *Schwarzkopf v. John H. Breck, Inc.*, 144 USPQ 433 (C.C.P.A. 1965) (Opp. at 4), the opposer objected to the applicant's attempt to register a silhouette design that included the disclaimed wording "Children Shampoo". The opposer maintained two registrations which also utilized silhouette designs and claimed that the applicant's mark created a likelihood of confusion. Thus, the issue in *Schwarzkopf v. John H. Breck, Inc.* centered on similar silhouette designs, not whether any confusing similarity existed through applicant's use of disclaimed, descriptive wording. In fact, it was the opposer that contended that the disclaimed wording - "Children Shampoo" - should not be part of the likelihood of confusion analysis. The reason why the opposer argued this point was because the applicant's inclusion of descriptive language helped to obviate consumer confusion. *Schwarzkopf*, 144 USPQ 433, 434 ("The [B]oard gave as reasons for deciding that issue in the negative its view that the marks of the parties are readily distinguishable, opposer's silhouettes being of a woman while applicant's is obviously intended to be that of a child..." thus, applicant's use of the descriptive wording "Children Shampoo").

Second, in *In re Shell Oil Co.*, 26 USPQ2d 1687 (Fed. Cir. 1993), the Federal Circuit reviewed the applicant's appeal of the Trademark Office's refusal to register its stylized RIGHT-A-WAY mark² due to the registration of another stylized RIGHT-A-WAY mark.³ In *In re Shell*,



the applicant's mark and the registered mark contained identical wording and incorporated arrow designs. So while the principle of law cited by the Opposer is correct (Opp. at 4-5), a review of the facts of the proceeding demonstrates that the decision in *Shell Oil* does not apply to the present factual situation as both the disclaimed wording and the stylizations were similar and at issue. *In re Shell Oil Co.*, 26 USPQ2d 1687, 1689 ("The Board placed weight on the identity of the words RIGHT-A-WAY, and the presence of an arrow design in both marks...We agree with the Board that the words dominate these marks, and that their differences in script and arrow design do not diminish their substantial identity when viewed as a whole.").

Similarly, Opposer misapplies the decision by the Court of Customs and Patent Appeals in *Industria Espanola De Perlas Imitacion, S.A., et al. v. National Silver Company*, 173 USPQ 796 (C.C.P.A. 1972) (Opp. at 5), as the marks in dispute both contained crest designs and the wording "MAJORCA". *Industria Espanola*, 173 USPQ 796, 798 ("Our decision is bolstered by the fact that the composite mark incorporating the term MAJORCA within a crest design is similar to Industria's crest design which is frequently displayed in association with appellants' word mark MAJORICA."). In the present dispute, there is no issue with regards to the adoption of a fanciful sunflower design by Applicant.

Lastly, Opposer's reliance on *Giant Food, Inc. v. Nation's Foodservice, Inc.*, (Opp at. 5) is also misplaced as the likelihood of confusion claim is premised not only the parties' use of the

mark “Giant”, but also the incorporation of similar designs. *Giant Food*, 218 USPQ 390, 395 (Fed. Cir. 1983) (“From a distance, both marks reveal a word written across a circular or oval-shaped object. In both marks the “G” and the “T” of GIANT are located partially outside of the oval or circular portion of the designs.”)

Thus, while Applicant does not dispute that “disclaimed portions of trademarks must be considered in the likelihood of confusion analysis” (Opp at 4), the Opposer has failed to cite any support for the proposition that a likelihood of confusion can exist from Applicant’s descriptive use of a merely descriptive phrase when Opposer has objected to no other component of its composite Sunflower Mark.

B. The Opposition Does Not State an Actionable Claim.

Despite its admission that the words “herb farm” may be merely descriptive, Opposer erroneously argues that Applicant’s use of the words “herb farm” is not “in a truly descriptive sense.” Opp. at. 7. Opposer continues, “Applicant’s product is not an herb farm.” This is an incorrect application of the merely descriptive standard.

To state that Applicant’s product is “not an herb farm” is to state the test for genericism, not mere descriptiveness. The phrase “Herb Farm” is merely descriptive if it directly and immediately conveys some knowledge of the characteristics of its products. *See In re MBNA America Bank, N.A.*, 67 USPQ2d 1778, 1780 (Fed. Cir 2003) (“A mark is merely descriptive if it immediately conveys information concerning a quality or characteristic of the product or service.”). According to Section 1209.01(b) of the TMEP, “A mark is merely descriptive if it

describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods.” “The determination of whether a mark is merely descriptive is considered in relation to the identified goods, not in the abstract.” *In re Abcor Dev. Corp.*, 200 USPQ 215, 217 (C.C.P.A. 1978). Thus, we need only examine the words “herb farm” in relation to the goods covered by Applicant’s application to determine if they describe an ingredient, quality, characteristic, function, feature, purpose or use of the herbal supplements and medicinal herbal preparations; herbal tea and herbal food beverages; and herbal juices. And the answer is an unequivocal yes – the words “herb farm” describe/identify Applicant’s goods as originating or coming from or being grown on an herb farm. To be sure, the Board need only look at Applicant’s entered disclaimer of the “herb farm” phrase as this is an express admission by Applicant that this wording is indeed merely descriptive and used by Applicant to describe its goods. Further, this disclaimer of the “herb farm” phrase necessarily limits the scope of Applicant’s rights, and as a matter of law defeats Opposer’s likelihood of confusion claim.⁴

⁴ Opposer incorrectly claims that Applicant argued in its motion that Opposer’s pled registrations “should be denied protection under the Lanham Act.” Opp. at 2. Applicant made no such claim, and Applicant notes that Opposer included no such citation in its brief. Nonetheless, while Applicant reserves its rights to challenge Opposer’s pled registrations, Applicant contends that any scope of protection afforded Opposer’s pled registrations is very narrow in scope. Consequently, the scope of protection afforded Opposer’s pled registrations are not factual issues that preclude the Board from granting the pending motion. In other words, whether Opposer’s pled registrations are afforded an extremely wide scope of protection, or an extremely narrow scope of protection, neither has any effect on Applicant’s ability to use the merely descriptive phrase “herb farm”.

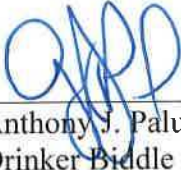
CONCLUSION

For the reasons stated above, and in Applicant's opening brief, Opposer cannot prevent Applicant from registering a mark in which the only overlapping element is a merely descriptive phrase that serves to identify and describe Applicant's products to consumers. Due to the absence of any issue of material fact, the Board should dismiss this proceeding in its entirety, and Applicant's Sunflower Mark trademark application should proceed to allowance.

Respectfully submitted,

SUNFLOWER MEADOWS HERB FARM

By:



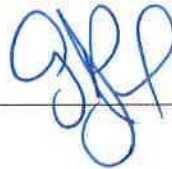
Anthony J. Palumbo
Drinker Biddle & Reath LLP
1500 K Street, NW, Suite 1100
Washington, D.C. 20005
Tel: (202) 842-8800
Fax: (202) 842-8465
dctrademarks@dbi.com

Counsel for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Applicant's Reply in Support of its Motion to Dismiss was served on Opposer's counsel at the following address of record by First Class Mail, postage prepaid, this 8th day of April 2013:

Tyler J. Volm
Elliott, Ostrander & Preston, P.C.
707 SW Washington Street, Suite 1500
Portland, OR 97205



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